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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/989,881	12/12/1997	JEN SHEEN	08472/716002	9398
21559	7590	11/03/2005	EXAMINER	
CLARK & ELBING LLP 101 FEDERAL STREET BOSTON, MA 02110			COLLINS, CYNTHIA E	
			ART UNIT	PAPER NUMBER
			1638	
DATE MAILED: 11/03/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

08/989,881

Applicant(s)

SHEEN, JEN

Examiner

Cynthia Collins

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>0704</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed August 22, 2005 in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 22, 2005 has been entered.

Claims 1, 24 and 36 are currently amended.

Claims 2-5, 8-23, 27-35 and 47-48 are cancelled.

Claims 1, 6-7, 24-26, 36-46 and 49-50 are pending and are examined.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

All previous objections and rejections not set forth below have been withdrawn.

### ***Claim Objections***

Claim 40 is objected to because of the following informalities: the reference to Fig 5 and the use of parentheses in the claim is confusing. Appropriate correction is required. It is suggested that the claim be amended to delete the reference to Fig 5 and the parentheses, and to simply recite "the nucleic acid sequence of SEQ ID NO:1".

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 25 and 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 25 and 26 are drawn to a seed and cell from a transgenic plant of claim 24, but are not limited to a seed and cell that comprise the substantially pure DNA that was used to transform the transgenic plant. A plant comprising a substantially pure DNA may not comprise a substantially pure DNA in all of its cells as transformation techniques often result in the production of chimeras. Accordingly a seed or a cell from such a plant also may not comprise a substantially pure DNA. Given that there is no indication that there are any other distinguishable characteristics of the claimed seed and cell, the claimed seed and cell are not distinguishable from seeds and cells that occur in nature. See *Diamond v. Chakrabarty*, 447 U.S. 303 (1980), *Funk Bros. Seed Co. V. Kalo Inoculant Co.*, 233 U.S. 127 (1948), and *In re Bergey*, 195 USPQ 344, (CCPA). The amendment of the claims to indicate that the seed and cell comprise the substantially pure DNA of the transgenic plant would overcome the rejection.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Murata N. et al. (Genetically engineered alteration in the chilling sensitivity of plants. Nature. 23 April 1992, Vol. 356, pages 710 - 713).

Claims 25 and 26 are drawn to a seed and cell from a transgenic plant of claim 24, but are not limited to a seed and cell that comprise the substantially pure DNA that was used to transform the transgenic plant. A plant comprising a substantially pure DNA may not comprise a substantially pure DNA in all of its cells as transformation techniques often result in the production of chimeras. Accordingly a seed or a cell from such a plant also may not comprise a substantially pure DNA. Given that there is no indication that there are any other distinguishable characteristics of the claimed seed and cell, the claimed seed and cell are not distinguishable from seeds and cells that occur in nature. Accordingly, claims 25 and 26 are anticipated by Murata N. et al. who teach tobacco plants which inherently comprise cells and produce seed. The amendment of the claims to indicate that the seed and cell comprise the substantially pure DNA of the transgenic plant would overcome the rejection.

***Allowable Subject Matter***

Claims 1, 6-7, 24, 36-39, 41-46 and 49-50 are allowed.

Claim 40 is objected to.

Claims 25-26 are rejected.

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***Remarks***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (571) 272-0794. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on (571) 272-0745. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cynthia Collins  
Primary Examiner  
Art Unit 1638

CC

  
10/27/05